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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YUE HENG XU

Appeal 2008-2549
Application 09/409,366
Technology Center 2100

Decided: November 21, 2008

Before JAMES D. THOMAS, LANCE LEONARD BARRY,
and HOWARD B. BLANKENSHIP, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1, 3 through 14, 31, and 32. We have jurisdiction over 35 U.S.C. § 6(b).

We note that this application was subject to a prior appeal 2003-1952 decided on October 14, 2004.

We affirm.

Appellant's invention relates to two electronic program guides of which independent claim 1 is illustrative:

1. A method of implementing an electronic programming guide through a program receiver comprising:

providing access to a first electronic programming guide with a first set of program selections;

providing access to a second electronic program guide with a second set of program selections wherein said second set of program selections is substantially more extensive than said first set of selections; and

enabling a user to select programs for viewing on said receiver from said first and second electronic programming guides.

The Examiner relies upon the following references as evidence in support of the art rejections:

Stautner	US 6,172,677 B1	Jan 9, 2001 (filing date Oct. 7, 1996)
Boyer	US 6,268,849 B1	Jul. 31, 2001 (filing date Jun. 30, 1998)

As set forth in the final rejection, the following rejections are applied to the noted claims on appeal:

1. Claims 3 through 6, 9, 11, and 12 stand rejected under the second paragraph of 35 U.S.C. § 112 as being indefinite.

2. Claims 1, 3, 7, 8, 10, 13, and 14 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Stautner.

3. Claims 4 through 6, 9, 11, 12, 31, and 32 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the Examiner relies upon Stautner in view of Boyer.

REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

To properly address this issue, we must first address certain preliminary matters.

The final rejection mailed on March 20, 2006, included the above-stated three rejections of the claims on appeal. A Brief was filed on August 8, 2006, arguing each of them. The Examiner's first Answer was mailed on November 2, 2006, but it did not include the rejection of the noted claims on appeal under the second paragraph of 35 U.S.C. § 112. On April 6, 2007, the Examiner noted the filing of a Reply Brief on December 12, 2006. Subsequently, the Examiner issued a second Answer, the one in which we make reference and the last stated Answer. The only difference between the two stated Answers is the statement of the above-noted rejection of the various claims under the second paragraph of 35 U.S.C. § 112 was repeated from the Final Rejection in the second Answer and, therefore, not withdrawn by the Examiner. This second Answer thus cures an inadvertent defect in the initial Answer. No new Reply Brief has been filed following this last Answer.

Before the Brief was filed on August 8, 2006, an amendment was filed on April 11, 2006, in which Appellant presented certain amendments to the claims rejected under the second paragraph of 35 U.S.C. § 112. The responsive Advisory Action mailed on May 4, 2006, did not authorize the entry of this amendment. Therefore, the claims presented in the Brief as the claims on Appeal are incorrect since it presumes the entry of this amendment by the Examiner. The nature of the arguments presented at the top of page 10 of the Brief apparently presumes the entry of this amendment

but notes that "[i]t is possible that the examiner failed inadvertently to take note of those changes." Because the Examiner mailed the Answer on June 26, 2007, not making reference to the intervening Reply Brief file on December 12, 2006, the Examiner merely restated rejections that apparently were inadvertently not repeated from the final rejection in the initial Answer mailed on November 2, 2006.

Because the record reveals that the Examiner has not entered the amendment apparently overcoming the rejection of the various dependent claims under the second paragraph of 35 U.S.C. § 112, we sustain the rejection of them since, on their face, the Examiner is correct in noting at page 3 of the Answer mailed on June 26, 2007, that there is insufficient antecedent basis for the limitations regarding the first medium, said Internet, the Internet, and said second medium in the listed claims. Appellant's mention at the top of page 10 of the Brief that the Examiner possibly inadvertently failed to note the changes to the amendment, apparently is confirmed in a Request to Strike the second Examiner's Answer received on August 9, 2007. This Request was denied by the Board's Chief Appeals Administrator in an Order mailed on November 14, 2008, which stated that the second Answer did not in any way argue new rejections. Even if we consider the Request to be the filing of a second Reply Brief, which would be considered to be responsive to the second Examiner's Answer mailed on June 26, 2007, Appellant's position is unavailing. What is significant about the Request is the recognition at the bottom of page 1 of the Request that the Advisory Action did not indicate that the amendment to the various claims was entered. Appellant took no action before the Examiner before this

decision on appeal to reargue before the Examiner what he already knew, namely, that the Examiner had not entered the amendment after final rejection over coming the rejection of the noted claims under the second paragraph of 35 U.S.C. § 112. Once the Examiner cured the apparent defect in the first Examiner's Answer by restating what was already in the final rejection from which Appellant appeals, on the facts before us, we are must agree with the Examiner's positions since there are no arguments on the merits pertaining to the unamended claims.

REJECTION OF THE CLAIMS UNDER 35 U.S.C. § 102(e)

Since pages 10 and 11 of the principal Brief on appeal treat the subject matter of independent claims 1 and 10 together because they have corresponding subject matter, we consider the argued features of independent claim 1 as representative of both of them. No dependent claim within this rejection has been argued in the principal Brief on appeal.

At issue here is the contention of Appellant that claim 1 includes two clauses for two different electronic program guides which Stautner does not teach. Essentially, the same position is presented in the Reply Brief filed on December 12, 2006. Representative independent claim 1 does not require per se that the second electronic program guide be "different" than the first electronic program guide. On the other hand, as a practical matter, because the second program guide is stated to be "substantially more extensive than said first set of selections (in the first program guide), we will consider claim 1 as essentially requiring different first and second program guides.

As to what Stautner actually teaches, we observe first that the abstract is directed to an integrated content guide for a multiple sources of information including hyper-text type links to include links to on-line services. The brief description of the drawing at column 3 of Stautner indicates that figure 3 shows a graphical display as to what would occur when a given link is followed in figure 2. From an inspection and comparison between the showing in figure 2 and that in figure 3, notwithstanding the corresponding discussion of them beginning at column 4, it is apparent to us that the artisan would well consider the showing at figure 3 to be substantially more extensive than the selection presented in the first showing of a program guide in figure 2 to the extent recited in representative independent claim 1 on appeal.

Contrary to the positions set forth at page 10 of the principal Brief on Appeal, the Examiner's principal reliance upon figures 2 and 5 of this reference is noted, but the contention that they represent separate embodiments is misplaced. In fact, the artisan, when reading the written description of this patent would understand that figures 3 through 5 illustrate variations of the embodiment illustrated in figure 2. Whereas the Brief description of figure 5 at column 3 illustrates an example of a display according to the invention showing possible television and non-television content items, the showing as well as the discussion of this figure at least at column 7 illustrates that additional, second or different web sites are available by icon identification for the user to select, such as the MSN and Time magazine web sites. Figure 4 even shows various online web sites that may be additionally selected by the user. Thus, the weight of the evidence

of the elements actually illustrated and discussed in Stautner as to the argued positions with respect to representative independent claim 1 on appeal well supports the Examiner's conclusion of anticipation of the argued features.

REJECTION UNDER 35 U.S.C. § 103

Appellant's positions set forth at page 11 of the principal Brief on appeal focus only upon the subject matter in dependent claims 31 and 32 on appeal, which appear to recite corresponding subject matter, and do not address any of the other features presented in any other dependent claim within this rejection. Additionally, Appellant does not argue that Stautner is not properly combinable with Boyer within 35 U.S.C. § 103.

Appellant's position focuses upon the straightforward urging that neither reference suggests different programming guides on different web sites. This position does not directly contest what the Examiner relies upon in the combination of teachings as to this argued feature. From our earlier discussion with respect to Strautner only, this reference would appear to teach the features of two program guides on two different web sites. The positions here also do not appear to take into account what Appellant has actually admitted to be in the prior art in the paragraph bridging Specification pages 1 and 2 that implicitly different program guides existed on a large number of different web sites and the succeeding paragraph indicating that various programs guides excited over networks, which are inclusive of web sites or Internet-based networks. Furthermore, the abstract of Boyer indicates that even associated with what appears to be one web site, the ability exists for accessing associated web pages or otherwise link pages compatible with the linking feature of Stautner, and would present to the

artisan the teaching that Boyer teaches different links or associated web sites in claims 31 and 32. The showing in figure 2 includes the capability of the user looking up zip codes in other localities and accessing their web sites. The weight of the evidence among the combined teachings of Stautner and Boyer therefore supports the Examiner's conclusion of the obviousness of the subject matter of argued dependent claims 31 and 32.

CONCLUSIONS OF LAW AND DECISION

Based on the above findings with respect to each of the above-stated rejections, we conclude that the Appellant has not met his burden of showing that the Examiner erred in rejecting claims 3 through 6, 9, 11, and 12 under the second paragraph of 35 U.S.C. § 112; in rejecting claims 1, 3, 7, 8, 10, 13, and 14 under 35 U.S.C. § 102(e); and in rejecting claims 4 through 6, 9, 11, 12, 31, and 32 under 35 U.S.C. § 103 as being obvious over Stautner in view of Boyer.

We therefore affirm the Examiner's decision rejecting claims 1, 3 through 14, 31, and 32.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. §1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

pgc

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